

REMARKS

Reconsideration of the present application is respectfully requested. Claims 1-7, 9-15, and new claims 16-20 are pending in this application after entry of the amendment. Claims 1, 9, 10, and 15 have been amended, without prejudice, to more specifically point out and distinctly claim the subject matter of their invention. Claim 8 has been cancelled, without prejudice or disclaimer. No new matter has been added.

Priority under 35 U.S.C. § 119

The Patent Office has indicated that none of the certified copies of the priority documents required in a claim for foreign priority under 35 U.S.C. § 119 have been received. The present invention is a continuation of (PCT/EP02/01370). **Applicants have included with this amendment** a photocopy of the proof of priority submitted in the parent case (PCT/EP02/01370) and request that this proof of priority be entered into the record.

Rejection under 35 U.S.C. § 112, second paragraph

Claims 1-7 and 9-15 were rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite. Claim 1 has been amended to clarify the distinction between “oleochemical polyol” and “diol”, and the distinction between “oleochemical polyol” and component “c”.

The Examiner is respectfully directed to the definition for “resin” provided by Applicants at page 12, line 21 to page 13, line 18 for clarification as to the meaning of this term. Moreover, Applicants submit that one skilled in the art would understand the scope and meaning of the term “resin”.

Although Applicants believe that the NCO/OH ratio is clear from the original claims, Applicants have amended claim 1 to address the Examiner’s comments and facilitate prosecution.

Claim 8 has been cancelled. The subject matter limitation has been incorporated into claim 1.

Claim 9 has been amended to properly depend from claim 1.

Claim 10 has been amended to clarify that the ethylenediamine therein may be propoxylated or ethoxylated, and to properly depend from claim 1.

Applicants respectfully submit that the term "loadbearing", found in claim 14, is a well known term of art in the building industry and refers to structural members that bear at least part of the weight or stresses of the structure in which they are associated.

Applicant further submit that the basis for the claimed weight percent in claim 15 has been clearly stated as "the water content of the wooden material" during the bonding process. However, to facilitate prosecution and further clarify that which they regard as the invention, Applicants have amended claim 15.

Rejection under 35 U.S.C. § 102(b)

Claims 1-7 and 9-15 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by DE 4401572. Applicants respectfully submit that DE 4401572 does not disclose each and every element of Applicants' claimed invention, as amended, and thus does not anticipate Claims 1-7 and 9-15 under 35 U.S.C. § 102(b).

Specifically, independent claim 1 recites: "A two-component polyurethane adhesive for wooden materials comprising components A and B wherein A) is: a polyol mixture containing at least a) 10 to 98 wt. % of at least one oleochemical polyol, b) 1 to 7.5 wt. % of at least one C₂-C₆ alkanediol having a hydroxyl value of 400 to 2000, c) 1 to 7.5 wt. % of at least one tri-, tetra-, or pentafunctional polyol having a hydroxyl value of 200 to 2000, the wt. % of each of a), b) and c) based on the whole of the polyol mixture, and d) a resin homogeneously dissolved in the polyol mixture, a resin homogeneously dissolved in the polyol mixture, wherein the resin is present in the polyol mixture at a level up to about 60 wt. %, based on the total weight of the polyol mixture, and B) is:

at least one polyisocyanate, wherein the NCO/OH ratio of components A) and B) is within the range of 1.5:1 to 0.9:1, and further comprising from 0 to 85 wt. %, based on the total weight of the adhesive, of at least one auxiliary substance." Support for the amendment to claim 1 can be found throughout the specification, for example, at page 12, line 21, again, at page 132, line 21, at page 15, beginning at line 23, and further at page 15, line 28.

It has not been asserted in the present Office Action that DE 44 01 572 A1 polyols contain a resin, thus, Applicants submit that DE 4401572 does not anticipate claims 1-7 and 9-15 (as amended).

Rejection under 35 U.S.C. § 103(a)

Claims 1-7 and 9-15 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over DE 4401572 in view of Uchigaki, et al. ('077) or Hartmann, et al. ('392) or Falkenstein, et al. ('064) or Brauer, et al. ('112) or Mori, et al. ('996) or Heider ('895 or '680). Applicants submit that, in light of the amendment to claim 1, the rejection 35 U.S.C. § 103(a) is rendered moot.

As noted above, the primary reference does not have a resin. The Examiner's position that it would be obvious to modify the primary reference to include a resin appears to be motivated by impermissible hindsight. Additionally, the combinations still fail to teach all limitations of the claims.

For example, the present invention requires resins that are **"homogeneously dissolved in the starting polyol mixture."** In contrast, Uchigaki, et al. ('077) fails to teach that the resin is dissolved in the polyol (see column 5, line 34 to column 6, line 2 which is limited to urethane prepolymers receiving tackifier resins). Likewise, Falkenstein, et al. ('064) generally discloses the addition of resins to *solvent-based* finished product polyurethane adhesives, but fails to disclose resin addition to polyol starting materials (column 7, lines 10-15). Similarly, Brauer, et al. ('112) discloses the use of extenders/resins in urethane prepolymers or finished product adhesive compositions (column 10, lines 64+), but not "homogeneously dissolved in the starting polyol mixture." Mori, et al. ('996) also discloses the addition of additives such as tackifier resins to finished adhesives, but, as with the foregoing, fails to disclose the use of resins in the starting polyol mixtures (column 3, lines 65 and 66). Heider ('895 or '680) too is limited to addition of resin additives in mixtures of urethane prepolymers (column 3, lines 66+ and column 4, lines 43+), and thus fails to teach that the resin is dissolved in the polyol.

The present invention also requires **"at least one C₂-C₆ alkanediol having a hydroxyl value of 400 to 2000"** and **"at least one tri-, tetra-, or pentafunctional polyol component having a hydroxyl value of 200 to 2000."** In contrast, Hartmann, et al. ('392)

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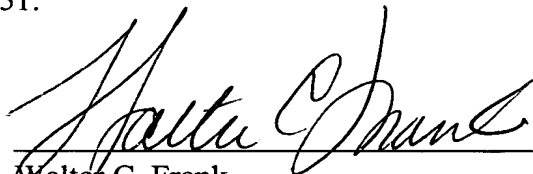
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discloses the use of polyols with hydroxyl values 20 to 85 (column 3, lines 11-16), well below Applicants claimed range. Likewise, Hartmann's resins must be compatible with polyols with hydroxyl values 20 to 85 (*see* column 4, lines 18+). Hartmann is also deficient because the present invention requires the homogeneous polyol-resin mixture to react with a polyisocyanates, and in contrast, Hartmann, et al. ('392) discloses *non-segregating* polyol-resin mixtures reacting with polyisocyanates, whose isocyanate moieties are masked with CH acidic compounds.

In view of the foregoing arguments, Applicants submit that a *prima facie* case of obviousness cannot be established using DE 4401572 in view of Uchigaki, et al. ('077) or Hartmann, et al. ('392) or Falkenstein, et al. ('064) or Brauer, et al. ('112) or Mori, et al. ('996) or Heider ('895 or '680).

If the Examiner wishes to discuss the claims or has questions, the Examiner is invited to contact the undersigned attorney at (215) 557-5951.

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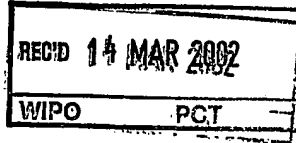
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PRIORITY DOCUMENT

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Prioritätsbescheinigung über die Einreichung einer Patentanmeldung

Aktenzeichen: 101 08 025.5

Anmeldetag: 19. Februar 2001

Anmelder/Inhaber: Henkel Kommanditgesellschaft auf Aktien,
Düsseldorf/DE

Bezeichnung: Zweikomponentiger Polyurethan-Klebstoff für
Holzwerkstoffe

IPC: C 09 J, C 08 G

Die angehefteten Stücke sind eine richtige und genaue Wiedergabe der ursprünglichen Unterlagen dieser Patentanmeldung.

München, den 21. Februar 2002
Deutsches Patent- und Markenamt
Der Präsident
Im Auftrag

Weinmayr